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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/557,289	11/18/2005	Takashi Nagashima	10873.1776USWO	7622

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EXAMINER

EVANS, GEOFFREY S

ART UNIT	PAPER NUMBER
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3742

MAIL DATE	DELIVERY MODE
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09/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/557,289	Applicant(s) NAGASHIMA ET AL.	
	Examiner Geoffrey S. Evans	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 5-14 and 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 15-18, 20 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20051118</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of the election of species in the reply filed on 25 June 2009 is acknowledged.
2. Claims 5-14 and 21-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 25 June 2009.
3. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3 the reference on line 2 of "the electrode" is confusing. Respectfully suggest using the phrase "the at least one electrode" instead since claim 2 recites "at least one of the first electrode and the second electrode is covered with an insulating cover. Similarly in claim 4 on lines 3 and 4 "the electrode" is confusing and should be replaced by the phrase "the at least one electrode".
4. Regarding claim 1, no patentable weight is being given to the phrase "for removing a metal coating provided on a surface of a resin" since it is not found in the main body of the claim and is unnecessary to breathe life and meaning into the claims.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
6. Claims 1, 2 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt in U.S. Patent No. 3,538,308. Schmidt discloses a first electrode (E_0), a

Art Unit: 3742

second electrode (E_1) a discharge energy supply section (see circuit in figure 1 and column 2, lines 63-67). Regarding claims 2 and 18, Schmidt further discloses an insulator (element I) between the two electrodes and covering the entire first electrode except for a small portion.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kerlin in U.S. Patent No. 4,501,947. Kerlin discloses first and second electrodes (20, 21) and a discharge energy supply section for supplying current (see circuit in figure 1).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerlin in view of Salsgiver et al. in U.S. Patent No. 4,931,613. Salsgiver et al. discloses

Art Unit: 3742

in column 5, lines 15-26 that discharges will create a plasma gas cloud between the electrode and the workpiece (the workpiece in Salsgiver et al. is the equivalent of one of the electrodes in Kerlin). It would have been obvious to adapt Kerlin in view of Salsgiver et al. to provide this to level of power to increase material removal which would create a plasma, which would further assist in removing material.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kerlin in U.S. Patent No. 4,601,947 in view of le Fur et al. in U.S. Patent No. 4,425,496 and Yuasa et al. in U.S. Patent No. 5,523,687. Kerlin discloses using two electrodes opposed to a workpiece, the electrodes being supplied with electric discharge energy to remove material from the workpiece. Kerlin does not disclose that the workpiece is a metal coating on a surface of a resin. Le Fur et al. teach removing a metal coating from a dielectric support material. Yuasa et al. teaches that metal coatings (aluminum film) can be supported by a plastic (resin). It would have been obvious to adapt Kerlin in view of le Fur et al. in view of Yuasa et al. to provide this to use the apparatus of Kerlin to remove a metal coating provided on a surface of a resin.

12. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerlin in view of le Fur et al. and Yuasa et al. as applied to claim 20 above, and further in view of Salsgiver et al. in U.S. Patent No. 4,931,613. Salsgiver et al. teach that discharges will create a plasma gas cloud between the electrode and the workpiece (the workpiece in Salsgiver et al. is the equivalent of one of the electrodes in Kerlin). It would have been obvious to adapt Kerlin in view of le Fur et al., Yuasa et al. and Salsgiver et al. to provide this to increase material removal. The plasma created by

Art Unit: 3742

removing material from at least one of the electrodes requires a preliminary discharge between the electrodes for plasma creation.

13. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 3 and 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Malshe et al. in U.S. Patent Application Publication No. 2008/0257867 discloses nano-scale electric discharge machining in which plasma is created during machining (see paragraph 79). Crespin in U.S. Patent No. 4,665,293 discloses in column 1, lines 13-22 that conventional devices for machining by electrical discharge create electric discharges of short duration in which plasma is created. Vitlin in USSR Patent Document No. 493,329 has an arc cutting electrode with an outer layer of electrical insulation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S. Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 7:30AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on (571)-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3742

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey S Evans/
Primary Examiner, Art Unit 3742